

REMARKS

Claims 1, 3-4 and 7-11 are pending in the present application. Claim 1 has been amended to recite “even when it is dried at 160°C”. Support for this amendment can be found on page 29, line 32 to page 30, line 10 of the specification under the “Thermal drying characteristics” evaluation method in the example. This amendment does not introduce any new matter.

Claims 1, 3-4 and 7-11 were rejected under 35 USC 103(a) over US Patent 5,330,627 to Gutter et al. (hereinafter also referred to as “Gutter”). Gutter does not render obvious Claims 1, 3-4 and 7-11.

Gutter suggests a thermosetting coating composition containing (A) one or more binders in liquid or dissolved form and (B) one or more binders in solid, particulate form.

However, in the thermosetting coating composition of Gutter (B) binders in solid, particulate form are converted into liquid or dissolved form at least at the curing temperature.

On the other hand, the organic fine particles in the paint composition for thermal drying of the present invention are ones which do not melt or decompose during thermal drying of the paint composition.

In the Example of Gutter, the plate coated with thermosetting coating composition is baked at 150°C in Example 17. This means that (B) binders in solid are converted into liquid or dissolved form at 150°C.

Therefore, the amendment to claim 1 clearly differentiates the paint composition for thermal drying of the present invention and thermosetting coating composition of Gutter.

Usually, since forming a thick film by thermal drying the emulsion, water in a yet-to-be dried film is evaporated after the surface of the film is dried, blisters are generated. Thus, blisters more easily occur as the film thickness increases. On the other hand, in the present invention, the composition contains organic fine particles which have a specific particle diameter and do not melt or decompose during thermal drying of the paint composition. The above-mentioned organic fine particles keep the solid form in the film, and thereby water in the film readily escapes when the emulsion forms a film to protect the occurrence of blisters and to improve the thermal drying characteristics.

Thus, as is described on page 18, line 11-18 of the present specification, the paint composition for thermal drying of the present invention is favorable as a thick film material since it can develop excellent thermal drying characteristics. Tables 1 and 2 show that the film thickness of from 1.5mm to 4.5mm (1500 to 4500 μm), prepared from the paint composition of the present invention, exhibits good thermal drying characteristics.

In Gutter, all of the coatings disclosed have a thickness of about 20 μm which is much thinner than the films that can be prepared from the paint composition for thermal drying of the present invention.

As explained above, blisters more easily occur as the thickness of the film increases and forming 1.5mm to 4.5mm thick films with no blisters is much more difficult than forming 20 μm thick films with no blisters. The paint composition of the present invention can provide a thicker film than the Gutter without the occurrence of blisters and it has excellent thermal drying characteristics.

In addition, as for vibration damping property, the thicker film has higher loss factor and higher vibration damping property, as shown in Tables 1 and 2 of the present specification. The present invention provides compositions which can form films that are much thicker than Gutter along with suppressing the occurrence of blisters. Also such thick films are advantageous in vibration damping property.

The present invention is achieved by optimization of the components of the composition, especially the organic fine particle and shows superior results and unexpected advantages as compared to the cited art. The cited reference disclosed nothing specifically with respect to the organic fine particle which does not melt or decompose during thermal drying, nor does it focus on the importance of such aspect.

The mere fact that the cited art may be modified in the manner suggested in the Office Action does not make this modification obvious, unless the cited art suggest the desirability of the modification. No such suggestion appears in the cited art in this matter. The Examiner's attention is kindly directed to *In re Lee* 61 USPQ2d 1430 (Fed. Cir. 2002), *In re Dembiczak et al.* 50 USPQ2d. 1614 (Fed. Cir. 1999), *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984), *In re Laskowski*, 10 USPQ2d. 1397 (Fed. Cir. 1989) and *In re Fritch*, 23, USPQ2d. 1780 (Fed. Cir. 1992).

Also, the cited art lacks the necessary direction or incentive to those of ordinary skill in the art to render under 35 USC 103 sustainable. The cited art fails to provide the degree of predictability of success of achieving the properties attainable by the present invention needed to sustain a rejection under 35 USC 103. See *Diversitech Corp. v. Century Steps, Inc.* 7 USPQ2d 1315 (Fed. Cir. 1988), *In re Mercier*, 187 USPQ 774 (CCPA 1975) and *In re Naylor*, 152 USPQ 106 (CCPA 1966).

Moreover, the properties of the subject matter and improvements which are inherent in the claimed subject matter and disclosed in the specification are to be considered when evaluating the question of obviousness under 35 USC 103. See *Gillette Co. v. S.C. Johnson & Son, Inc.*, 16 USPQ2d 1923 (Fed. Cir. 1990), *In re Antonie*, 195, USPQ 6 (CCPA 1977), *In re Estes*, 164 USPQ 519 (CCPA 1970), and *In re Papesch*, 137 USPQ 43 (CCPA 1963).

No property can be ignored in determining patentability and comparing the claimed invention to the cited art. Along these lines, see *In re Papesch*, supra, *In re Burt et al*, 148 USPQ 548 (CCPA 1966), *In re Ward*, 141 USPQ 227 (CCPA 1964), and *In re Cescon*, 177 USPQ 264 (CCPA 1973).

Accordingly, the assertion that the present claims are unpatentable over Gutter et al is untenable, and is respectfully traversed.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

In the event that the Examiner believes that an interview would serve to advance the prosecution of this application, the undersigned is available at the number noted below.

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Please charge any fees due with this response to our Deposit Account No. 22-0185, under Order No. 21581-00318-US from which the undersigned is authorized to draw.

Dated:

Respectfully submitted,

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